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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,309	02/27/2004	Masataka Mochizuki	249466US0DIV	4332
22850	7590	07/01/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			VORTMAN, ANATOLY	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/787,309

Applicant(s)

MOCHIZUKI ET AL.

Examiner

Anatoly Vortman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-38 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26,27 and 34-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Amendment*

1. The Applicant's amendment filed on 06/02/05 had been received. All claims of record 1-25 have been cancelled and new claims 26-38 have been added. Thus, claims 26-38 are pending in the instant application.

### *Election/Restrictions*

2. Newly submitted claims 28-33 are directed to an invention that is independent or distinct from the invention as originally elected, (i.e. Specie 2, Fig. 4).

Claims 28-33 are in agreement as to not being elected, because they read on Fig. 1-3, 5, and 6, depicting non-elected species. Claims recite "a grading layer", "a graphite layer", and "a lubricating material", the features characteristic of the non-elected species. The elected Specie II has none of the aforementioned features and Fig. 4 does not depict these features as well.

The Applicant has received an action on the merits for claims drawn to Specie II, because this invention has been elected for prosecution on the merits. Accordingly, claims 28-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Accordingly, action on claims 26, 27 and 34-38, which fall within elected Specie II, is follows.

### *Claim Rejections - 35 USC § 112*

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 26, 27, and 34-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 recites: "wherein the die or electronic part is joined to the heat spreader in a manner that no significant thermal stress is caused between the heat spreader and die or electronic part by heat generated by the die or electronic part". This is indefinite, since it is not clear what is encompassed by the recitation "joined... in a manner". In what manner? It is also not clear what is meant by the term "no significant thermal stress". This is a relative term. "No significant", relative to which benchmark ?

Claim 27 recites: "the gradient layer", which lacks antecedent basis.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 26, 27, and 34, as best understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US/6,317,322 to Ueki et al., (Ueki).

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Regarding claim 26, as best understood, Ueki disclosed (Fig. 9) an electronic device comprising: an electronic part or die (52) joined to a heat spreader (50) joined to a heat sink (51), wherein said heat spreader (50) comprises a sealed structure (501) encapsulating a condensable fluid therein which can repeatedly evaporate and condense to transport heat; and wherein the die or electronic part (52) is joined to the heat spreader (50) in a manner that no significant thermal stress is caused between the heat spreader (50) and die or electronic part (52) by heat generated by the die or electronic part (52).

Regarding claim 27, as best understood, Ueki disclosed that the die or electronic part (52) and heat spreader components (50) are selected to have about the same coefficients of thermal expansion such that they do not generate significant thermal stress between the gradient layer and the die or electronic part or heat spreader.

Regarding claim 34, Ueki disclosed that said electronic part (52) is a semiconductor chip (see column 2, lines 26-31), thus it inherently comprises silicon.

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueki taken alone.

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Regarding claims 35 and 36, Ueki disclosed all, but that the heat spreader is made of the aluminum nitride or invar having specific ingredients (i.e. Mn, C, Ni, and Fe) and specific ratios of said ingredients (.4%, .2%, 36%, and 63.4%, respectively). The Official Notice is taken of the fact that aluminum nitride and invar having said ingredients have been notoriously known in cooling art at the time the invention was made as good materials for making heat conductive components of cooling systems and said ingredients were commonly used for making the invar at the time of the invention, thus it would have been obvious to a person of ordinary skill in the cooling art at the time the invention was made to select aluminum nitride or invar having aforementioned claimed ingredients for making the heat spreader of Ueki in order to achieve desired coefficient of thermal expansion of said heat spreader and desired rate of heat dissipation, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding the specific claimed ratios of the invar ingredients, these ratios are the result effective variables, wherein the result is a coefficient of thermal expansion of the heat spreader.

It would have been obvious to one having ordinary skill in the cooling art at the time the invention was made to select any appropriate ratios of said ingredients, including as claimed, in order to achieve the desirable coefficient of thermal expansion of the heat spreader, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 37 and 38, claims recite the way the electronic device is employed, i.e. that said electronic device is an MPU or an image processor. The Examiner would like to direct

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the Applicant's attention to the fact that the way said electronic device is employed does not affect the structure of the device. The cooling arrangement still would be the same, whether said device is an MPU, image processor, CPU, or any other heat producing component. What is important is only the fact that said component is producing the heat, which needs to be dissipated.

It would have been obvious to a person of ordinary skill in the electronic and cooling fields of endeavor to use the disclosed cooling arrangement of Ueki in conjunction with any electronic device in order to dissipate heat produced by said device and in order to satisfy the requirements of a particular specific application, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Response to Arguments***

9. The arguments are moot in view of the new grounds of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 571-272-2047. The examiner can normally be reached on Monday-Friday, between 10:00 am and 6:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Lynn Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anatoly Vortman  
Primary Examiner  
Art Unit 2835

AV

